

REMARKS

Claims 1-6 and 8-14 were previously pending in the application. Applicants respectfully request reopening of prosecution, withdrawal of the appeal, and reconsideration and withdrawal of the pending rejections in view of the following amendments and/or remarks. By this Amendment/Response, claims 1-6 and 8-14 have been amended to provide clarification, better track commercial implementations, and/or correct minor typographical informalities. Applicants submit that no new matter has been added by way of this Response. Claim 7 has been previously canceled without prejudice or disclaimer. Furthermore, Applicants maintain that the original claims are in condition for allowance and explicitly reserve the right to add/pursue the original claims at a later time and/or in one or more continuation/divisional applications. Claims 1-6 and 8-14 are currently pending in the application.

Claim Rejections - 35 U.S.C. § 101

Claims 1-6 have been rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Specifically, the pending Examiner's Answer alleges "[t]he broadest reasonable interpretation of applicant's claimed limitation as a whole encompasses a human being and thus is non-statutory under 35 U.S.C. § 101." (February 4, 2009 Examiner's Answer, p. 2, § 2). Although Applicants respectfully traverse this rejection and submit that claims 1-6 are directed to a method and not to a human being (the preamble of independent claim 1 recites "A method for computerized trading"), Applicants have amended independent claim 1 to provide clarification and better track commercial implementations. Amended independent claim 1 recites, *inter alia*, "receiving a plurality of trade parameters, the plurality of trade parameters characteristic of a desired trade." Applicants further note that the MPEP requires that

"[i]n evaluating whether a claim meets the requirements of section 101, the claim must be considered as a whole" (MPEP § 2106 IV C, emphasis added). In contrast, the Examiner's Answer has alleged that "applicant's claimed limitation as a whole ... is non-statutory under 35 USC 101," (February 4, 2009 Examiner's Answer, p. 2, § 2; emphasis added) which addresses claim elements in isolation and not in relation to the claim as a whole, as required, *inter alia*, by MPEP § 2106 IV C. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Claim Rejections - 35 U.S.C. § 102

Claims 1-2, 3, 5 and 8-14 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Kane, US 6,317,728 (hereinafter, "Kane"). Although Applicants respectfully traverse this rejection and submit that Kane fails to discuss or render obvious every element of the claims, Applicants have amended the claims to provide clarification, better track commercial implementations, and/or to correct minor typographical informalities.

Amended independent claim 1 recites, *inter alia*:

A method for computerized trading comprising:

...

loading a market-specific plug-in in the logic engine;

...

determining by the trade implementation plug-in and the market-specific plug-in an order strategy based on the plurality of trade parameters;

...

Applicants submit that Kane does not discuss or render obvious at least these elements of independent claim 1. Instead, Kane is directed to a trading system "having an input communicating with a securities exchange for receiving securities buy/sell data" that is processed by "decision logic" that "includes at least one decision agent, the agent representing a respective buy/sell rule" (Kane, Abstract). At no time does Kane discuss or render obvious "a

market-specific plug-in" or "determining by ... the market-specific plug-in an order strategy," as recited, *inter alia*, by independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claim 1, Applicants submit that claim 8 is patentable over Kane for at least similar reasons as discussed above identifying deficiencies in Kane with regard to independent claim 1. For example, amended claim 8 recites, *inter alia*:

An apparatus for computerized trading comprising:
...
- a market-specific plug-in in the logic engine;
...

Applicants respectfully submit that at lease these claim elements from independent claim 8 are not discussed or rendered obvious by Kane's system, as discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Although of different scope than claim 1, Applicants submit that claim 9 is patentable over Kane for at least similar reasons as discussed above identifying deficiencies in Kane with regard to independent claim 1. For example, amended claim 9 recites, *inter alia*:

An apparatus for computerized trading comprising:
...
- a market-specific plug-in in the logic engine;
...

Applicants respectfully submit that at lease these claim elements from independent claim 9 are not discussed or rendered obvious by Kane's system, as discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Furthermore, Applicants submit that claims 2, 3, 5 and 10-14, which depend directly or indirectly from independent claims 1 and 9 respectively, are also not anticipated or rendered obvious by Kane for at least similar reasons to those discussed above identifying

deficiencies in Kane with regard to the independent claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Claim Rejections - 35 U.S.C. § 103

Claims 4 and 6 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kane in view of Microsoft Computer Dictionary, 5th edition, page 345 (hereinafter, "MCD"). Applicants respectfully traverse this rejection and submit that the applied references, taken alone or in combination, fail to discuss or render obvious every element of the claims and that a *prima facie* case of obviousness has not been established.

Applicants submit claims that claims 4 and 6 are patentable over Kane for at least similar reasons to those discussed above identifying deficiencies in Kane with regard to independent claim 1. Dependent claim 4 depends from independent claim 1 and is believed to be patentably distinct from the applied references for at least similar reasons. Although of different scope than independent claim 1, amended independent claim 6 recites, *inter alia*,

A method for computerized trading comprising:

...

- loading a market-specific plug-in in the logic engine;

...

determining by the trade implementation plug-in and the market-specific plug-in an order strategy based on the plurality of trade parameters by deconstructing the ComplexOrder into Events and Actions by the trade implementation plug-in;

...

Applicants further submit that MCD, which provides definitions of computer-related terms, fails to remedy the deficiencies identified above in Kane with regard to independent claim 1.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Furthermore, Applicants submit that the Examiner's Answer has failed to properly set forth the differences in the claims over the applied references and to explain why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made by dissecting the claim elements and evaluating them in isolation, by failing to provide sufficient objective rationale for modifying the references, and by not providing a discussion of ordinary skill in the art. MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

MPEP § 2106 II C prescribes that "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation." The Examiner alleges, "the method of deconstructing complex order into event/action is old and well known" and "it would have been obvious to one of ordinary skill in the art to implement this well-taught modular design method in Kane to allow programmers to debug and recover very quickly from program crashes." (February 4, 2009 Examiner's Answer, p. 7, § 6). Applicants respectfully traverse this argument and submit that the Examiner has merely alleged obviousness of claim elements in isolation and has provided no discussion or explanation as to why the Examiner believes the claim elements would have been obvious to one of ordinary skill in the art in relation to the claim as a whole.

MPEP § 2141.02 I prescribes that "the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." (original emphasis). As the assertions of obviousness in

the Examiner's Answer are directed to the alleged differences in the claims over the applied art and do not discuss or even allege obviousness in relation to the claims as wholes, Applicants submit that the claims have been impermissibly dissected and that a *prima facie* showing of obviousness has not been made. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request clarification as to how and specifically why the Examiner believes he proposed modifications of the applied reference would have been obvious to one of ordinary skill in the art at the time of the invention in relation to the claim as a whole.

Applicants further submit that the Examiner has not put forth sufficient objective rationale for modifying the applied references. By way of example only, Applicants note that, while the Examiner's Answer acknowledges that "Kane does not explicitly teach the step of deconstructing said complex order into events and actions," it goes on to allege that "it would have been obvious to one of ordinary skill in the art to implement this well-taught modular design method in Kane to allow programmers to debug and recover very quickly from program crashes." (February 4, 2009 Examiner's Answer, pp. 7-8, § 6). Applicants respectfully traverse this argument and submit that "to debug and recover very quickly from program crashes" is overly general and does not point beyond either reference to a combination or modification thereof. Applicants are unclear as to how the Examiner believes the supposed advantages of debugging and recovering very quickly from program crashes allegedly point to a modification of Kane's system to one of ordinary skill in the art at the time of the invention.

MPEP §2141 (III) states, *inter alia*, "The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious," and that, "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Accordingly, Applicants submit that a *prima facie*

showing of obviousness has not been made and respectfully request reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicants respectfully request clarification as to how the Examiner believes debugging and recovering very quickly from program crashes allegedly points to a modification of Kane's system.

Applicants also submit that the Examiner has provided no indication of the level of ordinary skill in the art. MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." The Examiner's Answer refers to "one of ordinary skill in the art," (e.g., February 4, 2009 Examiner's Answer, p. 7, § 6) but has provided no indication or discussion of which art is described or the level of ordinary skill associated therewith. The Examiner's reference to "the art" is overly general and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states, "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." Applicants submit that impermissible hindsight has been applied in asserting obviousness of the various claim elements without providing an indication and analysis of the level of ordinary skill. As such, Applicants respectfully request that, if the Examiner maintains the rejection, that the Examiner discuss the level of ordinary skill in the art at the time of the invention and provide a clear analysis of why the claimed subject matter would have been obvious to one possessing that level of skill.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claim elements, there was/is no reason, rationale or motivation (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)) for such a combination of references, and the

claimed inventions are not admitted to be prior art. Thus, the Applicants respectfully submit that the supporting remarks and claimed inventions, claims 1-6 and 8-14 all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed here or in previous amendments/responses, Applicants assert that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserve the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants do not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicants respectfully request allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-341. In the event that an additional extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-341.

Respectfully submitted,
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